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Supreme Court of New York. Special Term, March 1877.

FRANCIS KINNEY v. JULIA BASCH ET AL.

While the rule is well settled that geographical words and numerical characters of a descriptive nature cannot be appropriated as trade-marks, courts of equity will restrain the use of such words and characters where they are adopted and employed for purposes of deceit.

Plaintiff used the designation "St. James," and the numerical symbol " $\frac{1}{2}$," to distinguish his cigarettes. Defendants used the words "St. James Parish Perique Cigarettes" and the symbol " $\frac{1}{2}$," applying the latter in the exact form employed by plaintiff. Although it was shown that the term "St. James Parish Perique" was one in common use and that the symbol " $\frac{1}{2}$ " was used by both plaintiff and defendants only on mixed cigarettes, an injunction restraining the use of both designations was granted.

THIS was a bill to restrain the infringement of certain trade-marks.

The plaintiff was a well-known manufacturer of cigarettes and used a label embracing (1) a representation of a field of divergent rays; (2) the words "St. James," and (3) the symbol " $\frac{1}{2}$," besides other features which were not subjects of controversy. The words "St. James" were conspicuously displayed in the plaintiff's label, and it was shown that his cigarettes were distinguished in the market by that name. Concerning the symbol " $\frac{1}{2}$," it was shown that plaintiff was the first to use it and that it assisted in the identification of his goods.

The defendants, who were manufacturers of little note, employed a label of the same size as plaintiff's, differing from it slightly in color. It bore the words "St. James Parish Perique Cigarettes," the words "St. James" being conspicuously displayed, and "Parish Perique Cigarettes," in some degree obscured by ornamentation. The symbol " $\frac{1}{2}$ " was an exact copy of that used by the plaintiff. In other respects the labels were substantially unlike. Defendants showed that there was a St. James parish in Louisiana; that St. James Parish Perique tobacco was a common article of commerce, and that plaintiff's cigarettes, as well as their own, were actually made of this kind of tobacco. Concerning the symbol " $\frac{1}{2}$," it was proved that it had been used only on mixed goods, and that both plaintiff's and defendants' goods were mixed. Sundry persons testified that this was the meaning attached by the trade to the symbol.

Rowland Cox and Charles Meyer, for plaintiff.

Christopher Fine, contrâ.

The opinion of the court was delivered by

VAN BRUNT, J.—This action is brought to restrain an alleged infringement or imitation of certain trade-marks of the plaintiff, which he has attached to certain cigarettes manufactured by him. The defendants claim that the labels which they attached to the cigarettes manufactured by them are not such imitations of the plaintiff's labels as would mislead the public, and that even if they were, no elements of property could ever be acquired in those words and symbols which the plaintiff claims were his trade-marks.

A careful inspection of the labels in question shows beyond a doubt that those of the defendants were adopted in order to deceive the public into supposing when they purchased the cigarettes of the defendants' manufacture that they were those of the plaintiff's manufacture.

As far as the use of the sun's rays are concerned, it seems to me the plaintiff has established beyond any reasonable doubt that he first adopted the device in connection with his manufacture of tobacco. The evidence to the contrary upon the part of the defence is of the most meagre and unsatisfactory character. The plaintiff has entirely failed to show any right to the exclusive use of the word "corporal," it being clearly shown that that word has been used in connection with manufactured tobacco for many years prior to its appropriation by the plaintiff.

The only remaining question to be considered is the right of the plaintiff to the exclusive use of the words "St. James," and the figures " $\frac{1}{2}$ " upon his labels.

It has been urged upon the part of the defendants that geographical names cannot be the subject of a trade-mark; neither can numerals, which only serve to indicate the nature, kind, or quality of an article.

It is true that the cases cited by the defendants sustain these propositions; but the later cases have proceeded upon different and more equitable principles in defining the grounds upon which courts of equity interfere in cases of this description.

This interference, instead of being founded upon the theory of protection to the owners of trade-marks, is now supported mainly to prevent frauds upon the public. If the use of any words, nume-

rals or symbols is adopted for the purpose of defrauding the public the courts will interfere to protect the public from such fraudulent intent, even though the person asking the intervention of the court may not have the exclusive right to the use of these words, numerals or symbols. This doctrine is fully supported by the latest English cases of *Lee v. Haley*, Law Rep. 5 Ch. App. Cases 155; and *Wotherspoon v. Currie*, Law Rep. 5 House of Lords, English and Irish Appeals 508; and, also, in the case of *Newman v. Alford*, 51 N. Y. 189.

It is claimed by the defence that the use of the numerals " $\frac{1}{2}$ " by the plaintiff is intended to represent that these cigarettes are made one-half of Perique and one-half of Turkish tobacco. Although the fact may be that the cigarettes may be thus composed, yet the numerals used do not by any means indicate this fact. They may as well relate to price, to size, to quality, to numbers, as to the quality of tobacco, and, consequently, cannot be descriptive of any particular quality except as they have been so used in connection with the plaintiff's label.

It seems to me, therefore, that the plaintiff is entitled to protection in the use of these numerals in connection with his cigarettes: *Gillot v. Esterbrook*, 47 Barb. 455.

It being apparent that the use of the words "St. James," by the defendants is intended to defraud the public into the belief that when they buy cigarettes with those words upon the labels, they were buying cigarettes of the plaintiff's manufacture, the court will necessarily interfere for the protection of the public.

It is urged that the defendants' labels are no imitations of the plaintiff's. I am led irresistibly to the conclusion that the adoption of the label by the defendants was solely because they thought the public might be deceived; and the differences were made in the hope that they might avoid possibly the damages arising from the use of a perfect imitation.

I am of the opinion, therefore, that the plaintiff is entitled to an injunction, restraining the defendants from the use of the device of the "sun's rays" upon their cigarettes, and also, from the use of the numerals " $\frac{1}{2}$ " and the use of the words "St. James" in connection therewith.

The view announced in this opinion is advanced, but may be safely said to be settled law.

Courts of equity are not misled by

plausible excuses. The worst fraud is that which bears on its face the semblance of conscience. If the facts show that the respondent is using the truth

as a cloak for fraud, equity will pursue and check him the same as if the fraud was apparent on the surface of the case.

The principle above stated is sustained by the most authoritative cases, and will, probably, not be controverted.

From it the courts have deduced a corollary, which has come to be a recognised rule in the law of trade-marks, that may be stated as follows :—

If the facts show that the respondent is using an imitation of complainants' trade-mark, it is no defence that the simulated mark is technically descriptive.

This proposition of law is not less certainly established than the broad principle from which it flows. In its application distinctions of the nicest character arise, but they present only the difficulties that are incidental to every investigation where the fraud complained of is not so clumsy that it is axiomatically plain.

The rule that descriptive words cannot be directly or indirectly monopolized, is not open to doubt. But it has never been so distorted as to enable a party to make it available in the defence of a fraud. On the contrary it has been found, as matter of fact, in all the cases, that the descriptive character of the word or words was indisputable. In nearly every instance the word or words had been applied by the plaintiff in such a manner that they described his goods. It is believed that there is not a case in the books where a descriptive word has been used by a defendant to simulate an arbitrary word used by a plaintiff in which an injunction has been refused. There is a manifest difference between a case in which

it is sought to sustain a descriptive word and one where it is sought to enjoin the use of a technically descriptive word which is a simulation of one that is not descriptive. In the former case plaintiff has no right to stand upon; in the latter his right to his mark is conceded, and the question is simply how far the court will go in protecting him.

But whatever the cases touching words of a descriptive nature decide, they are not to be construed to conflict with those cited by the court in the principal case. There is not, it is thought, more than the semblance of confusion. The fair deduction from the two classes is this :

Words of a descriptive nature are publici juris; but where a descriptive word is used by a person as a means of effecting a fraud, an injunction will issue: especially if it appears that the descriptive word was selected by reason of its being similar to a word in use by another, rather than on account of its being appropriate and well understood.

This is, in effect, the rule stated by Judge FANCHER, in the case of *Lea v. Wolff*, 1 Am. Law T. Rep., N. S. 400, wherein he says: "Geographical words cannot be appropriated as trade-marks; but the rule has its exception where the intention in the adoption of the descriptive word is not so much to indicate the place of manufacture as to intrench upon the previous use and popularity of another's trade-mark."

The tendency of courts of equity is to advance the principle quite as far as it has been carried by the accomplished author of the opinion in the principal case.

ROWLAND COX.